

REMARKS

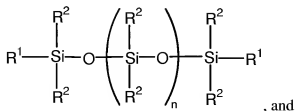
Claims 4-6 and 10-18 remain in the application, with claims 17 and 18 in independent form. None of the claims have been presently amended.

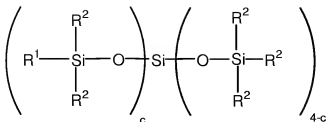
The Examiner has maintained the rejection of claims 4-6 and 10-18 under 35 U.S.C. 102(b) over Krammer et al. (U.S. Patent Application No. 2001/0021387). The Examiner has further rejected claims 4-6, 10-11, 17, and 18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Rejections Relving on 35 U.S.C. 102(b)

In maintaining the rejections under 35 U.S.C. 102, the Examiner has indicated that "it is the Examiner's position . . . [that] the claimed organopolysiloxane compound claimed [*sic*] only requires at least one anhydride group, and the cited prior art does disclose such a compound . . .". The Applicants once again respectfully assert that the Examiner has misinterpreted the scope of the claims, and has further misinterpreted the effect of Krammer et al. on the claims as they presently stand.

Claims 17 and 18 claim, in relevant part, that the organopolysiloxane has a formula selected from the group of:





wherein R^1 represents an anhydride group and c is from 1 to 4, among other limitations. In effect, the claimed organopolysiloxanes encompass those that are either

- 1) linear organopolysiloxanes that include more than one anhydride group (represented by the first of the two formulae above), or
- 2) *branched* organopolysiloxanes that may include a single anhydride group but that may also include multiple anhydride groups, depending on the value of c .

As such, it is obvious that the first of the two formulae must include more than one anhydride group, and the Examiner's rejection must necessarily be based only upon the presence of the second of the two formulae. While the organopolysiloxane represented by the second formula may include a single anhydride group, **the second formula is neither disclosed, taught, nor suggested by the disclosure of Krammer et al.** More specifically, Krammer et al. does not disclose, teach, or suggest *branched* organopolysiloxanes. The Examiner surely appreciates that the number of anhydride groups in the organopolysiloxane is only one of many features of the organopolysiloxane, and the fact that Krammer et al. merely discloses organopolysiloxanes having a single anhydride group is insufficient to establish anticipation of organopolysiloxanes having other features **that are not** disclosed in Krammer et al. The branched nature of the organopolysiloxane represented by the second of the two formulae is clearly not anticipated by Krammer et al. As such, the Applicants

respectfully submit that the rejections under 35 U.S.C. 102 have been overcome by the prior amendments to the claims, and that the claims are in condition for allowance.

Rejections Relying on 35 U.S.C. 112

The Examiner has relied on 35 U.S.C. 112 to reject claims that employ the language "selected from the group of . . ." as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Applicants respectfully traverse these rejections.

First, Applicants wish to point out that several claims have been added that contain claim language with the phrase "wherein [X] is selected from A, B, and C." Support for this alternative claim language can be found in several places, e.g., Appendix AI (PCT) of the M.P.E.P. (Specifically, Example 20, p. AI-44 of the July 1998 edition). Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph - Enablement Chemical/Biotechnical Applications, released August, 1996. (Specifically, Examples H and J.) These examples make it clear that the phrase "X selected from A, B, and C" is proper claim language, and therefore, new claims 17 and 21-25 should not be rejected under 35 U.S.C. §112, second paragraph, for improper claim language.

With respect to the specificities of Markush claims, under 2173.05(h) of the MPEP, the only requirement for alternative expressions, i.e., Markush groups, is that they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. In fact, in this same section, the MPEP actually recognizes that alternative forms of Markush groups are acceptable ("[w]hen materials recited in a claim are so related as to constitute a proper Markush group, they *may be* recited in the *conventional manner, or alternatively*."

emphasis added). Applicants respectfully submit that the scope and clarity of claims 4-6, 10-11, 17, and 18 are very clear, definite, unambiguous, etc. and that the mere selection of the open-ended terminology “comprising” does not render these claims in violation of § 112, second paragraph. For example, independent claims 17 and 18 are definite because the language at issue is merely defining the claimed organopolysiloxane. To appropriately further define the organopolysiloxane, the Applicants are not required to “close off” this further definition to organopolysiloxanes beyond those represented by the two formulae.

The Commissioner is authorized to charge the Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys, P.C., for any fees or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS

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Date

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